

## REMARKS

The office action of April 26, 2004 has been reviewed and its contents carefully noted. Reconsideration of this case, as amended, is requested. Claims 1 through 39 remain in this case.

### Preliminary Comments

The numbered paragraphs below correspond to the numbered paragraphs in the Office Action.

### Rejection under 35 U.S.C. §102

3. Claims 1-5, 10, 13, 14, 26, 27, 29 and 30 were rejected under 35 U.S.C. 102(b) as being anticipated by Itoh (U.S. Patent No. 4,559,564). Applicant respectfully disagrees with the rejection.

"Unless all of the same elements are found in exactly the same situation and united in the same way to perform the identical function in prior pleaded art, there is no anticipation." *Stauffer v. Slenderella Systems of California, Inc.*, 254 F.2d 127, 115 USPQ 347 (9th Cir. 1957).

Claim 1 reads "a fiber for use in an electronic display, wherein said fiber comprises: a) at least one electrode; and b) a lens function designed into at least a part of said fiber." In contrast, Itoh et al discloses an image reader or image sensor. Their device shines light on a piece of paper and captures the image from the paper to a digital file. An image sensor is not equivalent to an electronic display. An electronic display takes a digital file and displays it as an image that someone can view. Therefore, Itoh et al. does not teach an electronic display, but teaches an image sensor or image scanner.

Even assuming that Itoh et al. did disclose an electronic display (which the Applicant does not concede, see above), there is no fiber comprising "a) at least one electrode" in the patent. The Examiner does not point to what the fiber is in Itoh et al. Even if the Applicant assumes that the fiber optic lenses (32) in the patent are equivalent to the fiber (which the Applicant does not concede), the electrode (12) in FIG 2 is not comprised or contained in the

fiber optic lenses (32, Column 3 line 66). Therefore, claim 1 is not anticipated by Itoh et al. Reconsideration and withdrawal of the rejection of claim 1 is respectfully requested.

Regarding claims 3-4, the Examiner admits that "Itoh et al. do not explicitly disclose the lens function changes a direction and focus of the light passing through the fiber." (present office action dated April 26, 2004, page 3, lines 10-11) However, the Examiner states that Itoh et al. inherently meets the limitations of claims 3 and 4. As stated above, unless all of the elements are found in exactly the same situation and united in the same way to perform the identical function in prior pleaded art, there is no anticipation. Applicant knows of no "inherency" element in anticipation. If the Examiner disagrees, the Applicant respectfully requests that the Examiner specifically point to the patent law, the patent rules, or the M.P.E.P. to support her application of a reference "inherently" meeting the limitations of specific claims.

Regarding claim 10, the Examiner admits that "Itoh et al. do not explicitly disclose at least one reflecting region within the fiber or on the fiber surface." (present office action dated April 26, 2004, page 3, lines 16-17). However, the Examiner states that Itoh et al. inherently teaches the limitations of claim 10. As stated above, unless all of the elements are found in exactly the same situation and united in the same way to perform the identical function in prior pleaded art, there is no anticipation. Applicant knows of no "inherency" element in anticipation. If the Examiner disagrees, the Applicant respectfully requests that the Examiner specifically point to the patent law, the patent rules, or the M.P.E.P. to support her application of a reference "inherently" meeting the limitations of specific claims.

Regarding claims 13 and 14, the Examiner admits that "Itoh et al. do not explicitly disclose at least one part of the fiber is colored and the lens function corrects for a chromatic aberration." (present office action dated April 26, 2004, page 3, lines 20-21). However, the Examiner states that Itoh et al. inherently meets the limitations of claims 13 and 14. As stated above, unless all of the elements are found in exactly the same situation and united in the same way to perform the identical function in prior pleaded art, there is no anticipation. Applicant knows of no "inherency" element in anticipation. If the Examiner disagrees, the Applicant respectfully requests that the Examiner specifically point to the patent law, the patent rules, or

the M.P.E.P. to support her application of a reference “inherently” meeting the limitations of specific claims.

In addition, not only does Itoh et al. not disclose a colored fiber, they would not have any reason to add color to the fiber in their image sensor (which is not an display), because it would alter the color of the object they are trying to read.

Dependent claims 2-5, 10, 13 and 14, being dependent upon and further limiting independent claim 1, should also be allowable for that reason, as well as for the additional recitations they contain. Applicant respectfully requests reconsideration of the rejection of claims 2-5, 10, 13 and 14, in view of the above amendments and remarks.

Claim 26 reads “a fiber for use in an electronic display, wherein said fiber comprises: a) at least one wire electrode; and b) at least two transparent materials such that each of said transparent materials have a different index of refraction.” In contrast, Itoh et al discloses an image reader or image sensor. Their device shines light on a piece of paper and captures the image from the paper to a digital file. An image sensor is not equivalent to an electronic display. An electronic display takes a digital file and displays it as an image that someone can view. Therefore, Itoh et al. does not teach an electronic display, but teaches an image sensor or image scanner.

Even assuming that Itoh et al. did disclose an electronic display (which the Applicant does not concede, see above), there is no fiber comprising “a) at least one wire electrode” in the patent. The Examiner does not point to what the fiber is in Itoh et al. Even if the Applicant assumes that the fiber optic lenses (32) in the patent are equivalent to the fiber (which the Applicant does not concede), the electrode (12) in FIG 2 is not comprised or contained in the fiber optic lenses (32, Column 3 line 66). Therefore, claim 26 is not anticipated by Itoh et al. Reconsideration and withdrawal of the rejection of claim 26 is respectfully requested.

Regarding claim 29, the Examiner admits that “Itoh et al. do not explicitly disclose a plurality of alternating high and low index of refraction material regions are formed within the fiber such that the regions redirect light passing through the fiber”(present office action dated April 26, 2004, page 4, lines 3-5). However, the Examiner states that Itoh et al. inherently meets

the limitations of claim 29. As stated above, unless all of the elements are found in exactly the same situation and united in the same way to perform the identical function in prior pleaded art, there is no anticipation. Applicant knows of no “inherency” element in anticipation. If the Examiner disagrees, the Applicant respectfully requests that the Examiner specifically point to the patent law, the patent rules, or the M.P.E.P. to support her application of a reference “inherently” meeting the limitations of specific claims.

In addition, the Applicant disagrees with the Examiner’s statement that a device with a core and cladding structure has an alternating high and low index of refraction material when the light passes through it (present office action dated April 26, 2004, page 4, lines 5-7). When light enters an optical transmission fiber, it travels down the center of the optical fiber core. If you look at the physics of the light wave, it travels in and out of the cladding, especially when the fiber bends. But, in the direction where the light travels, the index of refraction does not alternate.

Dependent claims 27, 29, and 30, being dependent upon and further limiting independent claim 26, should also be allowable for that reason, as well as for the additional recitations they contain. Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 27, 29 and 30, in view of the above amendments and remarks.

### **Rejection(s) under 35 U.S.C. §103**

5. Claims 6, 7, 12, 36 and 37 were rejected under 35 U.S.C. 103(a) as being unpatentable over Itoh. Applicant respectfully disagrees. The argument above regarding the anticipation of claim 1 is hereby incorporated with respect to this rejection.

The basic considerations which apply to obviousness rejections under MPEP Section 2141 are:

- (1) the claimed invention must be considered as a whole;
- (2) the references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;

(3) the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and

(4) reasonable expectation of success is the standard by which obviousness is determined

Regarding claim 1, upon which claims 6, 7 and 12 depend, Itoh does not teach or suggest all of the limitations of the claim. More specifically, Itoh et al discloses an image reader or image sensor. Their device shines light on a piece of paper and captures the image from the paper to a digital file. An image sensor is not equivalent to an electronic display. An electronic display takes a digital file and displays it as an image that someone can view. Therefore, Itoh et al. does not teach or suggest an electronic display. Instead, they teach an image sensor or image scanner.

Even assuming that Itoh et al. did teach or suggest an electronic display (which the Applicant does not concede, see above), there is no fiber comprising “a) at least one wire electrode” in the patent. The Examiner does not point to what the fiber is in Itoh et al. Even if the Applicant assumes that the fiber optic lenses (32) in the patent are equivalent to the fiber (which the Applicant does not concede), the electrode (12) in FIG 2 is not comprised or contained in the fiber optic lenses (32, Column 3 line 66). Therefore, claim 26 is not anticipated by Itoh et al. Reconsideration and withdrawal of the rejection of claim 26 is respectfully requested.. Therefore, claim 1 is not obvious over Itoh et al.

Regarding claim 7, Itoh et al. uses a bundle of fibers to help collimate the light in the scanner and does not teach or suggest creating a lens function with a binary, Fresnel or lenticular lens.

Dependent claims 6, 7, and 12, being dependent upon and further limiting independent claim 1, should also be allowable for that reason, as well as for the additional recitations it contains. Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 6, 7 and 12, in view of the above amendments and remarks.

Claim 36 reads “a method of creating a fiber for use in an electronic display comprising the steps of : a) forming a preform including at least two distinct materials to be used in said fiber; and b) drawing said preform to form said fiber.” Itoh et al. does not teach “a method of

creating a fiber for use in an electronic display”, but teaches an image sensor or image scanner. Their device shines light on a piece of paper and captures the image from the paper to a digital file. An image sensor is not equivalent to an electronic display. An electronic display takes a digital file and displays it as an image that someone can view.

In addition, the Examiner states that “Itoh et al. disclose all the limitations of the claimed invention except for forming and drawing the preform to form the fiber. However, forming and drawing the preform are considered to be obvious, since the preform is commonly used in an optical communication system to form an optical fiber.” (present office action dated April 26, 2004, page 5, lines 13-15). Basically, the Examiner admits that Itoh et al. does not teach or suggest either of the steps of the claim.

"The deficiencies of the cited references cannot be remedied by... general conclusions about what is “basic knowledge” or “common sense” to one of ordinary skill in the art.... With respect to core factual findings in a determination of patentability,... the... [Examiner] cannot simply reach conclusions based on its own understanding or experience - or on its assessment of what would be basic knowledge or common sense. Rather, the... [Examiner] must point to some concrete evidence in the record in support of these findings." *In re Zurko*, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). Since the Examiner has not provided any concrete evidence to support her statements that the limitations of claim 36 are taught or suggested by the prior art, the obviousness rejection is overcome. Reconsideration and withdrawal of the rejection of claim 36 is respectfully requested.

Dependent claim 37, being dependent upon and further limiting independent claim 36, should also be allowable for that reason, as well as for the additional recitations it contains. Applicant respectfully requests reconsideration and withdrawal of the rejection of claim 37, in view of the above amendments and remarks.

6. Claims 15-17 and 31-33 were rejected under 35 U.S.C. 103(a) as being unpatentable over Itoh in view of Zelitt (5,790,086). Applicant respectfully disagrees. The argument above regarding the anticipation of claims 1 and 26 is hereby incorporated with respect to this rejection.

Regarding claim 1, upon which claims 15-17 depend, Zelitt does not provide what Itoh et al lacks. Zelitt teaches obtaining a 3-dimensional image from a 2-dimensional display by varying the apparent distance of the image from the viewer on a pixel by pixel basis. (Abstract). Zelitt does not teach or suggest a fiber for use in an electronic display, nor does Zelitt teach or suggest a fiber comprising at least one electrode. In fact, a fiber is not mentioned in Zelitt. Therefore, claim 1 is not obvious over Itoh et al. in view of Zelitt.

Dependent claims 15-17, being dependent upon and further limiting independent claim 1, should also be allowable for that reason, as well as for the additional recitations they contain. Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 15-17, in view of the above amendments and remarks.

Regarding claim 26, upon which claims 31-33 depend, Zelitt does not provide what Itoh et al lacks. Zelitt teaches obtaining a 3-dimensional image from a 2-dimensional display by varying the apparent distance of the image from the viewer on a pixel by pixel basis. (Abstract). Zelitt does not teach or suggest a fiber for use in an electronic display, nor does Zelitt teach or suggest a fiber comprising at least one wire electrode. In fact, a fiber is not mentioned in Zelitt. Therefore, claim 26 is not obvious over Itoh et al. in view of Zelitt.

Dependent claims 31-33, being dependent upon and further limiting independent claim 26, should also be allowable for that reason, as well as for the additional recitations they contain. Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 31-33, in view of the above amendments and remarks.

#### **Allowable Subject Matter**

7. Claims 8, 9, 11, 18, 19, 28, 34 and 35 were objected to as being dependent upon a rejected base claim, but the Examiner indicated that they would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Independent claims 1 and 26, upon which dependent claims 8, 9, 11, 18, 19, 28, 34 and 35 depend, should now be allowable, based on the arguments above. Therefore, reconsideration and withdrawal of the objection is respectfully requested.


Applicant respectfully thanks the Examiner for allowing claims 20-25, 38 and 39.

### Conclusion

Applicant believes the claims are patentable over the prior art, and that this case is now in condition for allowance of all claims therein. Such action is thus respectfully requested. If the Examiner disagrees, or believes for any other reason that direct contact with Applicants' attorney would advance the prosecution of the case to finality, she is invited to telephone the undersigned at the number given below.

"Recognizing that Internet communications are not secured, I hereby authorize the PTO to communicate with me concerning any subject matter of this application by electronic mail. I understand that a copy of these communications will be made of record in the application file."

Respectfully Submitted:  
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